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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,880	11/23/2005	Martin Burgbacher	095309.55997US	2235

23911 7590 09/30/2008  
CROWELL & MORING LLP  
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WASHINGTON, DC 20044-4300

EXAMINER
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KNIGHT, DEREK DOUGLAS

ART UNIT	PAPER NUMBER
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3681

MAIL DATE	DELIVERY MODE
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09/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 9/10/2008 have been fully considered but they are not persuasive.

Applicant argues "lines 19-27 in claim 15 define ***the manners*** in which release of an actuator-to-actuation element drive connection and transmission of forces or torques between drive and driven elements occur in the claimed gear selection device."

Emphasis added. Because those lines of the claim "define the manners" in which a release occurs and does not positively recite the elements or structure that is responsible for such a release it is considered to be functional language and a method step. "Apparatus claims cover what a device *is*, not what a device *does*." See MPEP 2114.

Applicant goes on to state "lines 19-27 in claim 15 do specify operations of certain elements of the claimed gear selection device," this is evidence that those lines of the claim only recite what the device *does* and does not disclose the structure of the device.

Applicant argues that the language the Examiner has deemed as functional cannot be ignored. MPEP 2114 states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the

structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)”

The functional language in the claims does not differentiate the claimed apparatus from the prior art. The structure to perform the "releasing operation" and the structure performing the "force and torque limiting operation" have not been claimed. There is also no claimed structure concerning "cooperation of the positively recited actuator and actuation element and cooperation of the actuator and the positively recited drive and driven elements."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEREK D. KNIGHT whose telephone number is (571)272-7951. The examiner can normally be reached on Mon - Thurs & every other Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D. K./  
Examiner, Art Unit 3681

/CHARLES A. MARMOR/  
Supervisory Patent Examiner, Art  
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